

REMARKS

Claims 1-26 remain pending in the application. Claims 1-10, 12 -18, 20 and 21 have been rejected, and Claims 11 and 19 have been objected to. The Applicants respectfully request favorable reconsideration in view of the following remarks.

I. ALLOWABLE SUBJECT MATTER

The Applicants thank the Examiner for the indication that Claims 11 and 19 would be allowable if rewritten in independent form to incorporate the elements of the base claims and any intervening claims. However, since the Applicants believe that the remaining claims in this application are patentable, the Applicants have not at this time elected to rewrite Claims 11 and 19 in independent form.

II. 35 U.S.C. § 102 REJECTIONS

Claims 1-10, 12-16, 20 and 21 stand rejected under 35 U.S.C. § 102 as being unpatentable over Bhuva U.S. Patent No. 5,612,713. These rejections are respectfully traversed for the following exemplary reasons.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Independent Claim 1 recites, “*memory elements configured to store data therein and shift data therebetween.*” The Office Action alleges that this feature is anticipated by the

memory cells 10a in Bhuva. However, Bhuva teaches that the memory cells 10a are loaded in blockwise fashion from a block load circuit 22. *See, e.g.*, Bhuva, column 4, at lines 52-54 and 61-64, and column 5 at lines 6-16 and 28-32. The Applicants have not found in Bhuva a teaching that the memory cells 10a are configured to “*shift data therebetween*” as recited in Claim 1. Accordingly, the next Office Action should either point out where Bhuva teaches that the memory cells 10a “*shift data therebetween*,” or withdraw the rejections of Claims 1-10, 12-16, 20 and 21.

For the exemplary reasons set forth above, the Applicants respectfully request that the Examiner withdraw the § 102 rejections of Claims 1-10, 12-16, 20 and 21.

III. REJECTIONS UNDER 35 U.S.C. § 103

Claims 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bhuva. These rejections are traversed for the exemplary reasons set forth below.

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2142.

Claims 17 and 18 depend ultimately from independent Claim 1, and therefore include the exemplary feature quoted above from Claim 1, namely, “*memory elements configured to store data therein and shift data therebetween*.” As is evident from the foregoing traversal of

the § 102 rejections, the Bhuvu memory cells 10a not only fail to anticipate this feature, but also clearly fail to suggest it. Accordingly, the § 103 rejections of Claims 17 and 18 are overcome for at least the same reasons given above with respect to the § 102 rejection of Claim 1.

For the exemplary reasons set forth above, the Applicants respectfully request that the Examiner withdraw the § 103 rejections of Claims 17 and 18.

IV. CLAIMS 22-26

The “DETAILED ACTION” section of the pending Office Action fails to address Claims 22-26. Moreover, the “Office Action Summary” indicates that Claims 22-26 are withdrawn from consideration. On the contrary, Claims 22-26 have been pending in this application since its filing date, and were in fact examined (and rejected) in the immediately preceding Office Action. The record does not contain any requirement for restriction, and the Applicants are not aware of any such requirement. Therefore, the Applicants respectfully traverse the aforementioned treatment of Claims 22-26 in the pending Office Action, and respectfully submit that the next Office Action should either reject Claims 22-26, allow Claims 22-26, or provide a properly formulated requirement for restriction.

Furthermore, inasmuch as no rejections of Claims 22-26 are currently pending, there is indisputably no pending issue between the Applicants and the Examiner regarding the patentability of Claims 22-26. Accordingly, the next Office Action cannot properly be final according to MPEP § 706.07, which states, “[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant.”

V. CONCLUSION


As a result of the foregoing, all Claims in the Application are now believed to be in condition for allowance, and an early allowance of such Claims is respectfully requested.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number or email address indicated below.

Respectfully submitted,

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